

**REMARKS**

Reconsideration of the April 11, 2003 Final Official Action is respectfully requested. Claims 26-40 and 43-55, as amended, are pending in the application for the Examiner's review and consideration.

Independent Claims 26 and 39 have been amended to recite a second layer including thermally opened perforations, said perforations being blocked by occlusions which block the flow of oxygen through the perforations until sufficient thermal energy by combustion of said smoking material opens said perforations, wherein the occlusions comprise a combustible filling material. Support for these changes can be found on page 14, lines 18-22 of the specification.

Claims 34 and 50 have been amended to recite that the perforations are evenly dispersed square perforations having dimensions of about 0.5 mm by 0.5 mm. Support for these changes can be found on page 11, lines 9-11 of the specification. Claims 38 and 54 have been amended to recite that the combustible filling material comprises a cellulosic or wax-like material. Support for these changes can be found on page 14, lines 18-22 of the specification. Claims 35-37, 51-53 and 55 have been amended for consistency. As no new matter has been introduced by these changes, they should be entered at this time.

Claims 26-33, 39-40 and 43-48 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,345,955 to Clearman et al. ("Clearman"). The reasons for the rejection are set forth in numbered paragraph 2 on pages 2-3 of the Official Action. This rejection is respectfully traversed.

In order to establish anticipation under 35 U.S.C. §102(b), all elements of the claim must be found in a single reference. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 90 (Fed. Cir. 1986), *cert. denied*, 107 S. Ct. 1606 (1987). In particular, as pointed out by the court in *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1981), *cert. denied*, 469 U.S. 851 (1984); "anticipation requires that each and every element of the claimed invention be disclosed in a prior art reference." In the present case, Clearman clearly fails to anticipate or render obvious the claimed subject matter.

Independent Claim 26 recites a cigarette wrapper for a cigarette having reduced sidestream smoke between puffs, comprising a first layer of combustible material adapted to be formed around smoking material; and a second layer of combustible material formed around said first layer, wherein said second layer reduces combustion of said smoking material between puffs, wherein said first layer is more combustible than said second layer when exposed to thermal energy generated by said smoking material, and said *second layer includes thermally opened perforations*, said perforations being blocked by occlusions which block the flow of oxygen through the perforations until sufficient thermal energy by combustion of said smoking material opens said perforations, *wherein the occlusions comprise a combustible filling material.*

Independent Claim 39 recites a smoking article having reduced sidestream smoke between puffs, comprising a smoking material; a first layer of combustible material formed around said smoking material; and a second layer of combustible material formed around said first layer, wherein said second layer reduces combustion of said smoking material

between puffs, wherein said first layer is more combustible than said second layer when exposed to thermal energy generated by said smoking material, and said *second layer includes thermally opened perforations*, said perforations being blocked by occlusions which block the flow of oxygen through the perforations until sufficient thermal energy by combustion of said smoking material opens said perforations, *wherein the occlusions comprise a combustible filling material.*

As recited in the specification at page 14, lines 18-22, occlusions can be formed blocking the perforations in the outer wrapper by filling in the perforations with a material such as cellulosic or a wax-like material that burns or melts when exposed to thermal energy.

Clearman discloses "a non-burning or foil-backed ... paper wrapper 29 [that] minimizes or prevents peripheral air (*i.e.*, radial air) from flowing to the portion of [a] fuel element disposed longitudinally behind its forward edge" (See column 6, lines 1-14). The wrapper has "an appropriate porosity to permit the carbonaceous fuel to obtain the air needed for burning" (See column 6, lines 27-29). While Clearman discloses a porous wrapper, Clearman does not disclose or suggest a wrapper comprising *thermally opened perforations* much less perforations being blocked by occlusions which block the flow of oxygen through the perforations.

Thus, Applicants respectfully submit that independent Claims 26 and 39 are patentable over Clearman. Dependent Claims 27-33, 40 and 43-48 are distinguished over

Clearman for at least the same reasons as discussed above with regard to independent Claims 26 and 39, and for the additional novel features that they recite.

Claims 26-34, 37-40, 43-48, 50 and 53-55 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 4,832,057 to Bale et al. ("Bale"). The reasons for the rejection are set forth in numbered paragraph 3 on pages 3-4 of the Official Action. This rejection is respectfully traversed.

Bale provides "an apparatus for making a smokeable cigarette from a preformed inherently unsmokable rod of tobacco and a separate sheet of cigarette paper" (See abstract). Bale discloses a preformed rod of smoking material 18 contained within a first wrapper such as teabag tissue 19 (See column 4, lines 38-64). The teabag tissue can be replaced by "impermeable or permeable paper" (See column 5, lines 5-15). The rod being already wrapped in a layer of teabag tissue can be overwrapped by a sheet of cigarette paper 22 (See column 6, lines 10-55 and Figure 15). However, Bale does not disclose or suggest a cigarette wrapper having thermally opened perforations, said perforations being blocked by occlusions which block the flow of oxygen through the perforations until sufficient thermal energy by combustion of said smoking material opens said perforations, wherein the occlusions comprise a combustible filling material, as recited in independent Claim 26 and 39.

Applicants respectfully submit that Claims 26 and 39 are therefore patentable over Bale. Dependent Claims 27-34, 37-38, 40 43-48, 50 and 53-55 are distinguished over Bale

for at least the same reasons as discussed above with regard to Claims 26 and 39, and for the additional novel features that they recite.

Claims 35-36, 49 and 51-52 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bale in view of U.S. Patent No. 5,551,451 to Riggs et al. ("Riggs") and U.S. Patent No. 5,360,023 to Blakley et al. ("Blakley"). The reasons for the rejection are set forth in numbered paragraph 6 on pages 5-7 of the Official Action. The Official Action alleges that it would have been obvious to combine the composite layers of Riggs with the smoking article of Bale. The Official Action further alleges that it would have been obvious to combine the size, number and relative positioning of perforations disclosed by Blakley with Riggs and Bale. This rejection is respectfully traversed.

Claims 35-36, 49 and 51-52 depend from independent Claims 26 and 39 and thus are patentable over Bale, Riggs and Blakley for at least the same reasons that independent Claims 26 and 39 are patentable over Bale.

Riggs and Blakley fail to cure the above-described deficiencies of Bale with respect to Claims 26 and 39. Riggs was relied on for disclosing a second layer extending to a non-zero distance from the distal end of the smoking article and for the disclosure of a composite layer (See Official Action at pages 6-7). Riggs discloses "a non-burning paper wrapper 18 ... comprising three laminated layers" (See column 4, lines 58-65; column 5, lines 60-67 and Figure 1). Riggs further discloses an "outer paper wrapper 14 [that] may comprise one layer or may be prepared from a plurality of separate layers each having different porosity" (See column 5, lines 12-14); "a paper overwrap 17, which ... may be

treated (*e.g.*, coated) with a barrier material" (See column 5, lines 22-24); and cigarette paper 20 (See column 5, lines 39-42). Riggs does not disclose or suggest, however, a cigarette wrapper comprising a second layer having thermally opened perforations that are blocked by occlusions that comprise a combustible filling material. Riggs is completely silent as to a wrapper having perforations much less a wrapper having perforations blocked by occlusions.

Blakley was relied upon for disclosing a wrapper having plurality of perforations that can vary in their size, number and relative positioning (See Official Action at page 6). Blakley discloses a cigarette having a first inner wrapping material 25 and a second outer wrapping material 27 (See column 3, lines 16-22). The outer wrapping material can include a series of perforations 60 (See column 4, lines 12-25). Blakley does not disclose or suggest, however, a cigarette wrapper comprising a second layer having thermally opened perforations that are blocked by occlusions that comprise a combustible filling material. Blakley is completely silent as to a wrapper having perforations blocked by occlusions much less occlusions that comprise a combustible filling material.

Thus, for at least the reasons discussed above, the combination of Bale, Riggs and Blakley fail to teach or reasonable suggest all the claim limitations. Accordingly, Claims 26 and 39, as well as the claims dependent therefrom, are deemed patentable over the combination of Bale, Riggs and Blakley.

It is submitted that the differences between the claimed subject matter and the prior art are such that the claimed subject matter, as a whole, would not have been obvious at the time the invention was made to a person having ordinary skill in the art.

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In view of the foregoing, it is submitted that the present application is in condition for allowance and such action is earnestly solicited.

Respectfully submitted,

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